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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047536
Party	Plaintiff Distillerie Stock U.S.A. Ltd.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,452,996  
Registered May 22, 2001  
Mark: BORU

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Distillerie Stock U.S.A. Ltd.,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92047536
– against –	:	
	:	
Castle Brands Spirits Company Limited,	:	<b>OPPOSITION TO MOTION</b>
	:	<b>TO DISMISS</b>
Respondent.	:	
-----	x	

Petitioner, Distillerie Stock U.S.A. Ltd., submits the following partial opposition to the motion by Registrant to dismiss the petition for cancellation.<sup>1</sup> Although Petitioner believes the motion should be denied, should the Board conclude otherwise, Petitioner further requests leave to amend.

**ARGUMENT**

On a motion to dismiss under Rule 12(b)(6), “all well-pleaded allegations of the nonmoving party must be accepted as true.” Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc., 66 U.S.P.Q.2d 1355, 1358 (T.T.A.B. 2003), citing Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (T.T.A.B. 1992). Young v. AGB Corp., 152 F.3d 1377, 1379, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998). “In reviewing a complaint, the Board construes the allegations therein liberally, as required by Fed. R. Civ. P. 8(f). See TBMP

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<sup>1</sup> Petitioner agrees to withdraw the petition to the extent it raises claims under Section 2(d), 2(f) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1052(f) and 1125(c).

503.02.” Saint-Gobain Abrasives, 66 U.S.P.Q.2d at 1358. Dismissal is appropriate “if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations.” Young, 152 F.3d at 1379, 47 U.S.P.Q.2d at 1754, quoting Abbott Labs. v. Brennan , 952 F.2d 1346, 1353, 21 USPQ2d 1192, 1198 (Fed.Cir. 1991) (citations and internal quotations omitted).

The Petition to cancel alleges that:

Contrary to Registrant’s allegations made to secure registration of the mark BORU that it has made continuing bona fide commercial use of the mark since the alleged date of first use in 1999, Petitioner had never encountered any reference to Registrant’s BORU mark in commercial use until shortly before commencing the current proceeding. Upon information and belief, the registration has not been obtained and/or maintained in good faith.

(Petition ¶ 9.) Because of the striking similarity of the names BORA and BORU for alcoholic beverages – an issue that, as explained below, was also the central concern of the Trademark Office when Registrant applied for registration - and because of the lack of similar names in the field, Petitioner would have expected to have encountered the name sooner based on the Registrant’s allegations to the Trademark Office.

In numerous cases, the Board has established that registration of a mark or maintenance of a registration based on an inaccurate designation of goods or services and dates of use on such goods or services is a form of fraud requiring cancellation of the entire registration. Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 U.S.P.Q.2d 1917, 1928 (T.T.A.B. 2006); Medinol Ltd. v. Neuro Vasx Inc., 67 U.S.P.Q.2d 1205, 1210 (T.T.A.B. 2003). For this reason, and of course taking the allegations as true, Petitioner believes it has properly alleged that Registration No. 2,452,996 should be canceled pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064(3), on the grounds that it has been obtained and/or maintained fraudulently.

Even if there has been use on one product (vodka), which of course is a factual issue

beyond the scope of the present motion, on the face of the registration itself, Distillerie Stock has substantial reason to question whether Registrant has been selling both “distilled liquors” (plural) as well as “distilled spirits” (also plural), as specified in its registration, for as long as Registrant has contended in its submissions to the Trademark Office. In understanding what is meant by “distilled liquors and distilled spirits” as specified in the subject registration, it is essential to note that the Registrant itself specifically argued to the Trademark Office, in seeking to overcome a final refusal based on Distillerie Stock’s registration of the mark BORA (simply for one liqueur) that its mark encompassed multiple products. To obtain the registration in issue, Registrant thus represented as follows to the Trademark Office:

Authority upon which the Office Action relies recognizes the significant distinction between multiple liqueurs, on the one hand, and a single liqueur, on the other hand. Cf. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, National Association, 811 F. 2d 1490, 1493 (Fed. Cir. 1987) (nothing that “there is nothing in either [the registrant’s] registration or [the applicant’s] application that limits the use of the mark to any services narrower than ‘banking services’ generally”). In other words, any express narrowing of the goods on or in connection with a mark is used must be considered in a likelihood of confusion analysis. When [Distillerie Stock’s] express narrowing of its goods is considered here, any relatedness between the Applicant’s goods and the Registrant’s good becomes greatly diminished. Nevertheless, assuming *arguendo* that the Applicant’s goods and the Registrant’s good are properly classified as closely related, the commercial realities of the marketplace will minimize, if not eliminate, any likelihood of confusion between Boru and Bora.

See June 23, 2000 Response to Office Action at p. 8, attached hereto. (Emphasis added.) Under Trademark Rules of Practice § 2.122(b), the application files of the registration against which the petition for cancellation is filed “forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.” Petitioner thus believes that on a motion such as this, the Board can and should take judicial notice of the contents of the file history. Kourtis v. Cameron, 419 F. 3d 989 (9th Cir. 2005)

(taking judicial notice of a prior lawsuit in determining whether an issue litigated in the earlier lawsuit was identical to one raised in the case at bar); I. Meyer Pincus & Assoc. v. Oppenheimer & Co., 936 F. 2d 759, 762 (2d Cir. 1991) (finding that a court can consider the full text of SEC filings, prospectuses, analyst's reports and statements integral to the complaint); Wyser-Pratte Management Co., Inc. v. Telxon Corp. 413 F. 3d 553, 560 (6th Cir. 2005) (finding that when ruling on a motion to dismiss, a "court may also consider other materials that are integral to the complaint, are public records, or are otherwise appropriate for the taking of judicial notice").

Laying aside the intended distinction between "spirits" and "liquors"<sup>2</sup>, Registrant left no doubt it sold multiple such products, be they spirits or liquors. However, although confirming it sold multiple liquors and distilled spirits under the name BORU, and expressly arguing that its breadth of products was a basis to overcome the Final Refusal, Registrant appears to have offered under the name BORU only one product: vodka. Even now, shortly after Registrant filed declarations under Sections 8 and 15 of the Lanham Act claiming continuous sales of "distilled liquors and distilled spirits", Registrant appears to sell only vodka. Regardless what is the final determination by the Board whether the Registrant misrepresented to the Trademark Office what products it has sold and when, there are, at the very least, substantive factual questions what spirits and what liquors Registrant has sold, and even for its vodka, whether sales have been ongoing. These issues can not be resolved on a Rule 12(b)(6) motion.

Regarding Petitioner's claims under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), in In re Kayser-Roth Corp., 29 U.S.P.Q.2d 1379 (TTAB 1993), the Board explained:

To support a Section 2(a) refusal that a mark "falsely suggests a connection" with another person (including a corporation or an institution), it must be shown that the applicant's mark is the same as or a close approximation of a previously used name or identity of that other person; that the mark would be recognized as such

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<sup>2</sup> Use of the conjunction "and" indicates that Registrant meant to claim two types of goods, each type of which was claimed in plural. Discovery may be necessary to determine precisely what the Registrant meant.

(i.e., that the mark points uniquely and unmistakably to that person); that there is no connection between the person named by the mark and the activities performed by the applicant under the mark; and, that the person's name is of sufficient fame or reputation that a connection with such person would be presumed when the applicant's mark is used on its goods or services.

Id. at 1384-85 Citing Buffett v. Chi- Chi's, Inc., 226 U.S.P.Q. 428 (T.T.A.B. 1985) and Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 U.S.P.Q. 752 (T.T.A.B. 1985).

There is no requirement to plead an intent to trade on the good will of the registrant to state a prima facie case. S&L Acquisition Co. v Helene Arpels, Inc. 9 U.S.P.Q.2d 1221 (TTAB 1987).

BORU is a strikingly close approximation of Petitioner's BORA mark. Indeed, as noted, Registration No. 2,452,996 for the mark BORU was issued only after the applicant overcame a final refusal based on Distillerie Stock's well-known BORA mark for Sambuca liqueur. The Petition for Cancellation duly notes the same (Petition ¶ 8). Among the incorrect arguments made by Registrant was that BORA Sambuca is (or was) all-but unknown and that the parties products had co-existed for some (albeit limited) time without evidence of actual confusion. As discussed above, there is some question whether the Registrant's mark was in use on the goods claimed for the periods represented to the Trademark Office. Moreover, as alleged in the Petition "Distillerie Stock's BORA Sambuca ... is now among the best known, if not the best known such liqueur in this country and had indeed become a famous mark before the February 1, 1999 claimed first use date of Registrant's BORU mark." (Petition ¶ 5.)

But for Registrant's use of the name BORU, the virtually identical mark BORA does indeed refer uniquely to Registrant. Indeed, the unique likelihood of confusion (duly and repeatedly noted by the Examining Attorney) supports cancellation of Registration No. 2,452,996 pursuant to Section 2(a) of the Lanham Act. Likewise, its supports cancellation pursuant to Section 14(3) of the Lanham Act inasmuch as Registrant's subject mark is being

used to misrepresent the source of goods on or in connection with which the mark is used, with consequent injury to Petitioner and to the public. The marks are sufficiently similar; Petitioner's mark is well-known for alcoholic beverages; alcoholic beverages (which are regularly ordered by name) could not be more proximate, and Registrant knew of Petitioner's mark when it commenced using the subject mark BORU.

In Otto International, Inc. v Otto Kern, GmbH, 2007 WL 1577524 (TTAB 2007), the Board explained that the Petitioner's claims (including two obscure marks) were "of the type" alleged under Section 2(d), without clarifying what type of allegations these might be. Here there is already a substantial predicate set of facts supporting a claim of misuse given the repeated rejections of the subject mark by the Trademark Office itself, which were withdrawn based on misleading or false statements by Registrant as to the level of recognition of the subject mark, BORA and alleged third-party use of similar names in the alcoholic beverage industry. Moreover, in Otto International, notwithstanding the perceived inadequacies of pleading, the Board permitted the Petitioner leave to amend. Here too, should there be any question as to the adequacy of Distillerie Stock's pleading, leave is requested to amend the same.

WHEREFORE, Petitioner respectfully requests that this Registrant's motion be denied, together with such other and further relief (including, as need be, leave to amend) as the Board deems just and proper.

Dated: New York, New York  
July 26, 2007

Respectfully submitted,

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By:

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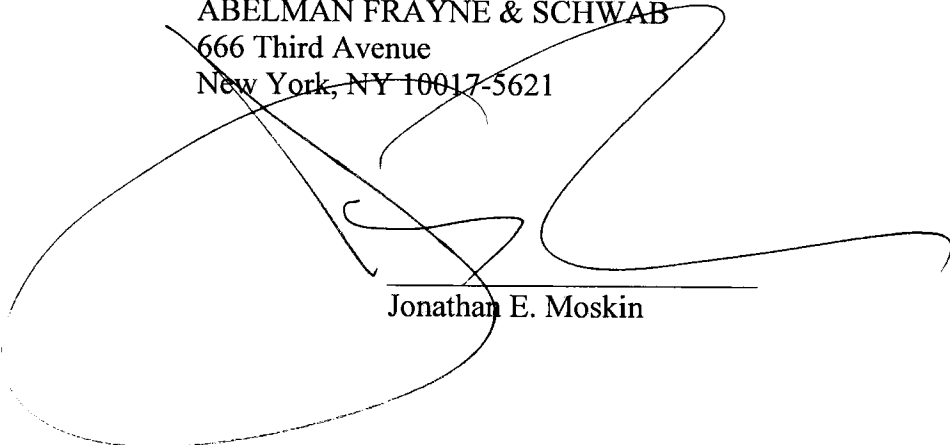
Attorneys for Petitioner,  
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**CERTIFICATE OF SERVICE**

I hereby certify that on the 26 day of July, 2007, I served a copy of the foregoing **OPPOSITION TO MOTION TO DISMISS** on the attorney for the Respondent by U.S. FIRST CLASS MAIL as follows:

JULIANNE ABELMAN  
ABELMAN FRAYNE & SCHWAB  
666 Third Avenue  
New York, NY 10017-5621



Jonathan E. Moskin

# Exhibit A



LAW OFFICES

**ANDREWS, HELD & MALLOY, LTD.**

06-26-2000

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**CERTIFICATE OF MAILING  
AND TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, Attention: Dawn J. Feldman, Trademark Attorney, on June 23, 2000. Further, this correspondence is being faxed to Dawn J. Feldman, Trademark Attorney, at (703) 308-7182, on June 23, 2000.

  
Dean A. Pelletier

June 23, 2000



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Filing Date: July 22, 1998  
Due Date for Response to  
Final Office Action:  
September 22, 2000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: The Roaring Water Bay Spirits Company Limited  
Examining Attorney: Dawn J. Feldman, Trademark Attorney, Law Office 111

**REQUEST FOR RECONSIDERATION OF FINAL OFFICE ACTION,**  
**PURSUANT TO 37 C.F.R. § 2.64(b)**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513  
Attention: Dawn J. Feldman, Trademark Attorney

McANDREWS, HELD & MALLOY, LTD.

Dawn J. Feldman  
June 23, 2000  
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Dear Ms. Feldman:

The Applicant, The Roaring Water Bay Spirits Company Limited, respectfully requests reconsideration of the Final Office Action, mailed on March 22, 2000 (the "Office Action"). The Applicant expressly incorporates into this Request its Response to Office Action No. 1, mailed on July 9, 1999 (the "July 9 Response"), all evidence in support thereof and all arguments raised therein.

**I. FINAL STATUTORY REFUSAL UNDER 15 U.S.C. § 1052(d)**

Upon considering all relevant factors set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973), there is no likelihood of confusion, deception or mistake between the Applicant's mark BORU and the Registrant's mark BORA. The denial of the Applicant's application to register the mark BORU should be reconsidered, and the Applicant's application should be granted. The totality of the circumstances, including the marks' distinct meanings, the marks' distinct commercial impressions, marketplace realities, more than sixteen months of confusion-free, concurrent use of the Applicant's mark BORU and the Registrant's mark BORA and the limited goods -- indeed, the only identified good -- on or with which the Registrant uses its BORA mark, dispels the notion that any confusion or likelihood of confusion exists, reinforces the conclusion that confusion is unlikely to exist and calls for the registration of the mark BORU.<sup>1</sup>

**A. All Relevant Facts Must Be Considered In Determining Whether There Is A Likelihood Of Confusion Between Two Marks.**

As set forth in the July 9 Response, determining whether there is a likelihood of confusion between two marks involves multiple inquiries, which must be assessed against the realities of the marketplace. *See DuPont*, 476 F.2d at 1361; and Trademark Manual of Examining Procedure ("TMEP") § 1207.01. To the extent that *In re Mack*, 197 U.S.P.Q. 755, 757 (T.T.A.B. 1977) stands for the proposition that similarity in sound, appearance or meaning "is sufficient to indicate likelihood of confusion[.]" that case misstates the law. *See In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n. 4 (T.T.A.B. 1987). Similarity of marks in one respect -- e.g., sight, sound or meaning -- does not automatically result in a likelihood of confusion, even if the goods are identical or closely related. *Id.*; *see also* TMEP § 1207.01(b)(i) and McCarthy on Trademarks, § 23:21. Similarity of marks in one respect may, after taking into account all relevant facts, support a finding of likelihood of confusion. *Lamson*, 6 U.S.P.Q.2d at 1042 n. 4.

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<sup>1</sup> The Applicant assumes, for purposes of this Request only, that the Registrant is actually using the mark BORA. (See July 9 Response, p. 9 n. 7.)

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**McANDREWS, HELD & MALLOY, LTD.**

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Significantly, marks that differ by a single letter and that are used on or in connection with related goods can be dissimilar enough to eliminate any likelihood of confusion.<sup>2</sup> This is the case here, particularly because the single letter difference between BORU and BORA constitutes 25% of each respective four-letter mark. (See July 9 Response, pp. 3-4.)

In fact, even identical or ostensibly identical marks used on related goods can create commercial impressions that are distinct enough to eliminate any likelihood of confusion. See, e.g., *In re Sears, Roebuck and Co.*, 2 U.S.P.Q. 2d 1312 (T.T.A.B. 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes); and *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (T.T.A.B. 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing).

Consideration of all relevant facts in this case supports the conclusion that there is no likelihood of confusion between BORU and BORA. The application to register the mark BORU should therefore be granted.

**1. BORU And BORA Possess Legally And Factually Distinct Meanings,  
And, Therefore, Create And Convey Commensurately Distinct  
Commercial Impressions.**

The Office Action does not contest the fact that BORU and BORA possess legally and factually distinct meanings. (See also July 9 Response, pp. 3-4.) The fact that BORU and BORA possess distinct meanings is significant because the marks' respective commercial impressions, on which the Office Action focussed (Office Action, p. 2), necessarily follow from their distinct meanings. *Sears*, 2 U.S.P.Q.2d at 1314. ("As a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance.") Cf. *Sydel*, 197 U.S.P.Q. at 630; and *British Bulldog*, 224 U.S.P.Q. at 856.

As explained in the July 9 Response, BORU is an arbitrary, or at least suggestive, mark possessing no literal meaning. BORU is a mark at least distinctively suggesting excellence in beverage quality as a result of the formidable military and political accomplishments of Brian Boru, an 11<sup>th</sup> century Irish warrior and leader. Further, at least some of the labels featuring BORU expressly refer to Ireland as the respective goods' country of origin, and some labels featuring BORU provide some explanation about the identity of Brian Boru, the former High King of Ireland. (See July 9 Response, pp. 10-11, Exhibit A attached hereto and the Applicant's

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<sup>2</sup> The Applicant recognizes that its and the Registrant's goods are related insofar as they are classified in International Class 33.

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Amendment to Allege Use and accompanying specimens, filed on July 9, 1999.)<sup>3</sup> Thus, the commercial impression created and conveyed by BORU suggests an Irish background and associated excellence.

BORA, on the other hand, possesses a literal meaning that is expressly set forth in Registration No. 1,272,086. BORA is defined by the Registrant as referring to “a cold northern wind which blows over the northern Adriatic.” (See July 9 Response, p. 4.) The file history for the mark BORA also expressly shows that sambuca liqueur is the only good on or with which BORA is used (see pp. 6-7, *infra*), and available labels featuring BORA expressly make clear that BORA sambuca liqueur is “Produced in Italy” (or, alternatively, a “Product of Italy”). (See July 9 Response, p. 4 n. 4 and exhibits referenced therein.)

A label’s identifying language can have a significant impact on a mark’s commercial impression:

Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to purchasers. [citation omitted.]

*In re Nationwide Industries, Inc.*, 6 U.S.P.Q.2d 1882, 1884 (T.T.A.B. 1988) (emphases added). See also *International Ass’n of Machinists and Aerospace Workers v. Winship Green Nursing Center*, 103 F.3d 196, 204 (1<sup>st</sup> Cir. 1996) (“we have recognized that in certain circumstances otherwise similar marks are not likely to be confused if they are used in conjunction with clearly displayed names, logos or other source-identifying designations of the manufacturer”) and *Aktiebolaget Electrolux v. Armatron International, Inc.*, 999 F.2d 1, 4 (1<sup>st</sup> Cir. 1993) (recognizing that “otherwise similar marks are not likely to be confused where used in conjunction with the clearly displayed name and/or logo of the manufacturer”).

BORA’s distinct meaning, its Italian background and the resulting commercial impression are inseparable. It is apparent that relevant purchasers and consumers would reasonably be aware of and recognize BORA’s Italian background and reasonably expect consistency between the particular characteristics of BORA sambuca liqueur and the characteristics of the referenced cold northern wind. BORA’s commercial impression is, in fact, manifest in the sambuca liqueur on or with which it is used. (July 9 Response, pp. 4-5.) Sambuca liqueur is an “anise-flavored [*a.k.a.* licorice-flavored], not-too-sweet Italian liqueur[.]” (July 9 Response, pp. 4-5; emphases added.) The refreshing characteristics of a cold northern wind parallel the licorice-flavor of sambuca liqueur. Thus, the particular commercial

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<sup>3</sup> The Applicant is not suggesting that, with respect to governing trademark law, such identifying language must or should always be used on its labels featuring the mark BORU. The Applicant is pointing out additional present marketplace realities to demonstrate that its mark BORU should be registered.

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impression created and conveyed by the mark BORA is a direct reflection of the particular good on or with which BORA is used, and BORA's Italian background contrasts starkly with BORU's suggested Irish background.<sup>4</sup>

The inference that BORU and BORA possess similar commercial impressions (Office Action, p. 2) is therefore not appropriate. The distinct meaning of each mark causes each mark to create and convey distinct commercial impressions that eliminate any likelihood of confusion.

**2. It Is Not Realistic To Conclude That Purchasers Or Consumers Are Likely To Be Confused By BORU And BORA.**

The Office Action's conclusion that BORU and BORA possess similar commercial impressions is specifically based upon the perception that the marks possess similar pronunciations and/or the possibility that consumers would mispronounce the marks. (Office Action, p. 2.) While the Applicant concedes, for purposes of this Request only, that there is not necessarily a correct way to pronounce a trademark, it is important to note that the cases cited for this proposition involved the following pairs of marks: (1) CAYNA and CANA, *In re Great Lakes Canning, Inc.*, 227 U.S.P.Q. 483 (T.T.A.B. 1985) and (2) SEIKO and SEYCOS, *Kabushiki Kaisha Hattori Tokeiten v. Scuto*, 228 U.S.P.Q. 461 (T.T.A.B. 1985). Thus, the Office Action's concerns about confusingly similar pronunciations might properly exist where (a) there is a single letter difference between marks and the letter(s) in question is (are) buried in the middle of the mark(s), (b) there are spelling differences between the marks and these differences consist of letters that are generally accepted phonetic equivalents of the other (e.g., "k" and hard "c" and "ei" and "ey"), (c) a plural and singular form of the same or phonetically equivalent terms are at issue and/or (d) there is an additional, silent letter in one of the marks (e.g., "c" vs. "ck"). No such circumstances exist here. In fact, the difference in spelling between BORU and BORA is a distinctly pronounced vowel at the end of each mark.<sup>5</sup> The literacy of the average consumer does not reasonably permit the inference or assumption that BORU and BORA will be identically pronounced or pronounced in a confusingly similar manner. *See Winship*, 103 F.3d at 201 ("the law has long demanded a showing that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care. [citations omitted.]"); *and Id.* at 204 ("We must presume that the class members are of normal intelligence"); *and New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194, 1202 (9<sup>th</sup> Cir. 1979) (assessing the likelihood of confusion question from the perspective of "a reasonable consumer of average intelligence and experience").

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<sup>4</sup> While BORA sambuca liqueur has an Italian background, the spelling and pronunciation of the mark BORA may also conjure up images of the island of Bora Bora. (*See* July 9 Response, p. 3.) Under such circumstances, the distinctions between BORU and BORA remain strong and, as a result, there is still no likelihood of confusion between the marks.

<sup>5</sup> *See also* July 9 Response, pp. 3-4 .

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It is also significant to note that the legal standard at issue is likelihood of confusion, not the mere possibility of confusion or the mere possibility that “[t]he marks in question could be pronounced the same.” (Office Action, p. 2; emphasis added.) See McCarthy on Trademarks, § 23.3 (“*Likelihood* of confusion has been said to be synonymous with ‘probable’ confusion - - it is not sufficient if confusion is merely ‘possible’ [citations omitted].” (italics in original).) See also *Winship*, 103 F.3d at 200 (“To demonstrate likelihood of confusion a markholder (or one claiming by, through, or under her) must show more than the theoretical possibility of confusion. [citations omitted.]”) (emphasis added). Mere possibilities are therefore not sufficient to deny the Applicant’s application to register BORU.

Further, purchasers’ (e.g., wholesale purchasers, restaurateurs, tavern, club or bar owners and retail distributors) and ultimate consumers’ selection of the Applicant’s and Registrant’s respective goods is generally based upon objective criteria and subjective tastes, respectively. (July 9 Response, pp. 5-6.) These respective goods are ingested by ultimate consumers. Thus, the purchasers and consumers of the Applicant’s and Registrant’s respective goods are sure to exercise heightened scrutiny in their purchasing decisions and properly ask for the precise goods which they desire, thereby minimizing, if not eliminating, any likelihood of confusion (assuming *arguendo* such a likelihood would otherwise exist). (See July 9 Response, pp. 5-6.)<sup>6</sup>

It is just not accurate to conclude that “[c]onsumers, who are sent for the registrant’s goods using the mark BORA, could easily assume that they heard wrong or that the name was mispronounced and pick up the applicant’s goods instead of the registrant’s goods.” (Office Action, p. 2.) Such a conclusion is based upon speculation, gives no meaningful consideration to the reasonable intelligence, experience and literacy of the average consumer and, as one of the cases relied upon in the Office Action recognizes, fails to fully appreciate marketplace realities:

As to a comparison of applicant’s mark with those of opposer, which includes “ECI”, per se, and as the most significant portion of the opposer’s other registered marks, the side-by-side comparison urged by applicant is not generally a true test in determining the question of the confusing similarity of marks in a proceeding of this character. This is necessarily so because, with the possible exception of shelf-items that are marketed in close proximity to one another, it is difficult to perceive that purchasers and prospective purchasers of goods of the type offered by applicant and opposer would usually have an opportunity for a side-by-side critical examination of the marks under which the products are sold. It is for this reason that it has been held that the question of likelihood of confusion must be based upon whether the subsequently used mark stimulates or triggers a recollection of a mark previously exposed to in a related or associated

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<sup>6</sup> This scrutiny will be exercised by wholesale purchasers, restaurateurs, tavern, club or bar owners and retail distributors, as well as ultimate consumers. (July 9 Response, pp. 5-6.)



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marketing situation, remembering that this recollection is often hazy and imperfect. [citations omitted.]

*ECI Division of E-Systems v. Environmental Communications, Inc.*, 207 U.S.P.Q. 443, 450 (T.T.A.B. 1980) (emphasis added).

Thus, the scenario contemplated by the Office Action is not realistic. A consumer sent for the Applicant's or Registrant's goods -- even if she assumed that she had heard wrong or that the name was mispronounced -- should have the "opportunity for a side-by-side critical examination of the marks under which the products are sold." Such an opportunity would minimize, if not eliminate, any likelihood of confusion. Further, any such confusion would, at best, be transient and therefore *de minimis*. (July 9 Response, p. 2 n. 1, pp. 9-10.) In other words, any confusion, assuming *arguendo* it existed, would be resolved by the salesperson or, for example, by the consumer's spouse, other family member or roommate (*i.e.*, when the consumer returned home with the wrong goods). See *Winship*, 103 F.3d at 201 ("This means, of course, that confusion resulting from the consuming public's carelessness, indifference, or ennui will not suffice" to establish a likelihood of confusion). (emphasis added.)

**B. The Applicant's Goods And The Registrant's Goods Are Distinct.**

There are sharp differences (*e.g.*, in taste) between the Applicant's and the Registrant's respective goods. (July 9 Response, pp. 4-5.) The Office Action does not dispute these differences. In addition, the Applicant's and Registrant's respective goods are not considered to be or accepted as substitutes, whether consumed alone or as part of a mixed drink. By way of example, a reasonable person might mix BORU vodka with orange juice to make a mixed drink known as a screwdriver. However, a reasonable person desiring a screwdriver would not substitute BORA sambuca liqueur for BORU vodka. Yet, the Office Action concludes that the Applicant's and Registrant's respective goods are "closely related" because, based upon ten trademark registrations (attached to the Office Action), "[m]any of the same companies produce both liqueurs and distilled spirits." (Office Action, p. 2.)

The Applicant respectfully disagrees with the statement that "[m]any of the same companies produce both liqueurs and distilled spirits" because, among other things, that statement is not sufficiently substantiated. Even assuming *arguendo* that it is sufficiently substantiated and true, that statement has not been shown to be a matter of common knowledge among relevant consumers. *Sears*, 2 U.S.P.Q.2d at 1314 n. 5. Thus, just because several registrants have identified multiple goods, including wines, distilled spirits and liqueurs, as the goods on or with which they use their respective marks, it does not necessarily follow that purchasers or consumers in the relevant marketplace generally associate distilled liquors and distilled spirits with liqueurs. Such a conclusion about marketplace realities is not supported by an abbreviated sampling of trademark registrations.

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The Applicant also notes the standard set forth in *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901 (C.C.P.A. 1973), another case upon which the Office Action relies. (Office Action, p. 2.) *Paula Payne* specifically held that “[t]rademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [citations omitted].” 473 F.2d at 902. Thus, it is significant that all ten of the registrations attached to the Office Action identify the plural term “liqueurs” as some of the goods on or with which each respective mark is used, whereas Registration No. 1,272,086 and its accompanying file history identify a single good -- sambuca liqueur -- on or with which BORA is used. (See Exhibit B hereto and July 9 Response, p. 4 n. 4 and all exhibits referenced therein.)<sup>7</sup>

Authority upon which the Office Action relies recognizes the significant distinction between multiple liqueurs, on the one hand, and a single liqueur, on the other hand. Cf. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, National Association*, 811 F.2d 1490, 1493 (Fed. Cir. 1987) (noting that “there is nothing in either [the registrant’s] registration or [the applicant’s] application that limits the use of the mark to any services narrower than ‘banking services’ generally”). In other words, any express narrowing of the goods on or in connection with a mark is used must be considered in a likelihood of confusion analysis. When the Registrant’s express narrowing of its goods is considered here, any relatedness between the Applicant’s goods and the Registrant’s good becomes greatly diminished. Nevertheless, assuming *arguendo* that the Applicant’s goods and the Registrant’s good are properly classified as closely related, the commercial realities of the marketplace will minimize, if not eliminate, any likelihood of confusion between BORU and BORA.

**C. There Has Been No Actual Confusion Despite More Than Sixteen Months Of Concurrent Use And The Applicant’s Extensive Presence In The Marketplace.**

The Applicant, in the normal course of its business, has, for more than sixteen months, been using its mark BORU in interstate commerce and with respect to goods in International Class 33. Hence, the Applicant’s mark BORU and the Registrant’s mark BORA have been concurrently used in interstate commerce, without any evidence of actual confusion, for more than sixteen months. This harmonious, concurrent use is especially significant given that the mark BORU is the focal point of a \$1 million marketing campaign. (July 9 Response, p. 9.) The absence of any evidence of actual confusion further calls for reconsideration of the denial of the application to register the mark BORU, and, indeed, supports the registration of BORU.

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<sup>7</sup> The Office Action’s statement that “[t]he registrant’s goods are liqueurs” is not supported. (emphasis added.)

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II. FINAL IDENTIFICATION OF GOODS OF REQUIREMENT

Applicant agrees to and accepts the following suggested recitation of goods, with respect to International Class 33: ["Distilled liquors and distilled spirits"] in International Class 33."

For the foregoing reasons, the Applicant respectfully requests reconsideration of the denial of the application to register the mark BORU. The Applicant believes, in light of the foregoing and its July 9 Response, that its mark BORU should be registered. Please feel free to contact the undersigned at 312/775-8128 if you have any questions or if you need additional information.

Very truly yours,

McANDREWS, HELD & MALLOY, LTD.

By: 

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